

**REMARKS**

Claims 1-4, 29, 30, 32, 33, and 39-41 are pending in the application.

Claim 29 has been allowed.

Claims 1-4, 30, 32, 33 and 39 have been rejected.

Claims 40 and 42 have been objected to.

Claims 1-4, 32, 33 and 39-41 have been amended, as set forth herein.

I. **ALLOWABLE SUBJECT MATTER**

The allowance of Claim 29, and the indication that Claims 40 and 41 are directed to allowable subject matter, is noted with appreciation. Applicant has deferred rewriting Claims 40 and 41 in independent form pending Examiner's reconsideration of the claim amendments herein.

II. **OBJECTIONS TO DRAWINGS AND REJECTION UNDER 35 U.S.C. § 112**

The drawings were objected to under 37 CFR 1.83(a). Claims 1-4, 32, 33 and 39-41 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.<sup>1</sup> The drawing objection and rejection are respectfully traversed.

However, Applicant has amended Claims 1-4, 32, 33 and 39-41 to recite, in general terms, (1) an apparatus comprising a network intelligence having one or more emulators (independent

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<sup>1</sup> Applicant notes that the Examiner previously issued no fewer than four (4) substantive office actions, having mailing dates of January 8, 2003, June 30, 2003, January 21, 2004 and July 14, 2004, each without raising such drawing objection and 112 rejection.

Claim 1), (2) an apparatus comprising a network intelligence and a control messenger (independent Claim 32) and (3) an apparatus comprising a network intelligence including a messenger (independent Claim 39).

Moreover, Applicant's specification adequately describes the "control messenger" and "messenger" as recited in independent Claims 32 and 39, respectively. Specification, see, the emulator 110 and/or the elemental control message formatter 108; Page 11, lines 1-7; Page 10, lines 24-26; and Page 6, lines 5-7.

Accordingly, the Applicant respectfully requests withdrawal of the drawing objection and § 112 rejection of Claims 1-4, 32, 33 and 39-41.

### III. REJECTION UNDER 35 U.S.C. § 102

Claims 1-4 and 30 were rejected under 35 U.S.C. § 102(b) as being anticipated by Focsaneanu, et al. (US 5,610,910). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Independent Claim 1 has been substantially amended, and now recites (1) a network intelligence for communicating IP messages to the data network telephone over the IP data network and facilitating provision of services for said data network telephone, wherein the network intelligence comprises (2) at least one terminal emulator operable for emulating the data network telephone, (3) a configuration data structure, (4) a first service proxy launched in response to a first input received at the data network telephone (based upon information in the configuration data structure), (5) a second service proxy launched in response to a second input received at the data network telephone, and (6) the first service proxy is operable for setting up a first service between a first data source and the data network telephone, and the second service proxy is operable for setting up a second service between a second data source and the data network telephone.

Independent Claim 30 has been amended, and now recites (1) a computer readable medium, which when loaded into a processor connected to an IP data network to which at least one telephone is also connected, controls the processor . . . , and (2) the user input messages from the telephone include IP messages received over the IP data network.

The Office Action has not identified each of these elements/features in Focsaneanu. Therefore, the cited reference does not appear to disclose each and every element/feature as recited in Applicant's claims (as amended).

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(b) rejection of Claims 1-4 and 30.

IV. REJECTION UNDER 35 U.S.C. § 103

Claims 32 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Focsaneanu, et al (US 5,610,910) in view of Wang, et al. (US 6,161,134). Claim 39 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Focsaneanu, et al (US 5,610,910) in view of Wong, et al. (US 5,881,103). The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness,

three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

As detailed above, Focsaneanu fails to disclose each and every element recited in Applicant's claims, as amended. Furthermore, neither Wang (equalization device for an coupled audio accessory) or Wong (combination of an information appliance and a telephone that can function independently or with each other), when combined with Focsaneanu, disclose, teach or suggest the Applicant's claimed invention. Wang does not appear applicable to an IP data network or refer to IP messages to/from a data network telephone. Wong does not appear to disclose, teach or suggest that its information appliance communicates with its telephone using IP messages over an IP data network.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejections of Claims 32, 33 and 39.

V. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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